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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,455	08/22/2001	Luc Adam	514442002300	7159

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EXAMINER	
KRUSE, DAVID H	

ART UNIT	PAPER NUMBER
1638	13

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/934,455	ADAM ET AL.	
	Examiner	Art Unit	
	David H Kruse	1638	

-- The MAILING DATE of this communicati n appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-70* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-70* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-33 and 44-47, drawn to an isolated or recombinant polynucleotide encoding a polypeptide that alters a trait of a plant, a transgenic plant transformed with said polynucleotide, and a method of making said transgenic plant, classified in class 800, subclass 290, for example.

II. Claims 34-43, drawn to an isolated or recombinant polypeptide, classified in class 530, subclass 370, for example.

III. Claims 48-51, drawn to a computer readable medium having stored sequence information, classified in class 369, subclass 30.01, for example.

IV. Claims 52-60 and 61-70, drawn to a method of identifying a homolog sequence form a database and the identified homolog sequence, classified in class 700, subclass 91, for example.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the polynucleotide and

transgenic plant of group I is structurally, compositionally and functionally distinct form the polypeptide of Group II.

3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the polynucleotide and transgenic plant of group I is structurally, compositionally and functionally distinct form the computer readable medium of Group III.

4. Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the method of identifying a homologous sequence of Group IV requires information and not the composition of matter, that being a polynucleotide, of Group I, claims 61-70 are interpreted as being directed to information identified by the method of claim 52 and not to a composition of matter.

5. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the isolated polypeptide of Group II is structurally, compositionally and functionally distinct form the computer readable medium of Group III.

6. Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the method of identifying a homologous sequence of Group IV requires information and not the composition of matter, that being a polypeptide, of Group II, claims 61-70 are interpreted as being directed to information identified by the method of claim 52 and not to a composition of matter.

7. Inventions III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method of identifying a homologous sequence from a database can be practice using a materially different product than the computer readable medium of Group III, such as by human manipulation of the database.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter, and because the search required for one of the groups is not required for another, restriction for examination purposes as indicated is proper.

9. Applicant is advised that the reply to this requirement to be complete within one month (not less than 30 days) must include an election of the invention to be examined even though the requirement be traversed (37 CFR § 1.143).

10. In addition, **Applicant is required to elect** one nucleic acid sequence and one encoded amino acid sequence (e.g. SEQ ID Nos. 1 and 2) to be examined in conjunction with the elected group of claims. The Patent and Trademark Office recently published its policy for the examination of patent applications that claim large numbers of nucleotide sequences in the Official Gazette, 1192 O.G. 68 (November 19, 1996). Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. § 121. Absent evidence to the contrary, each such nucleotide is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. § 121 and 37 CFR § 1.141. In establishing the new policy, the Commissioner has partially waived the requirements of 37 CFR § 1.141et seq. and permits a reasonable number of such nucleotide sequences to be claimed in a single application. It has been determined that normally ten sequences constitute a reasonable number for examination purposes. The Official Gazette Notice of November 19, 1996 is one that permits the examiner to waive restriction to no more than one invention. Since 1996, databases and resource allocations at the PTO have changed and the examination of 10 sequences on the merits in the instant application would present a burden on PTO resources. Additionally, it is noted that one nucleotide and one amino acid sequence is

within the O.G. notice range of "up to ten" sequences. This election is not to be construed as an election of species.

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (703) 306-4539. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Amy Nelson can be reached at (703) 306-3218. The fax telephone number for this Group is (703) 872-9306 Before Final or (703) 872-9307 After Final.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-0196.



David H. Kruse, Ph.D.
30 September 2003